

REMARKS

Claims 13-15, and 17-23 are pending. No new matter is added.

I. The drawing correction is submitted in the new format "replacement sheet" attached to the back of this amendment.

The words "PRIOR ART" have been added.

II. The 112 rejection is traversed because the objected to language is deleted herein in claim 13.

Also, "in the stereomicroscope" has been repeated in the body of the claims from the preamble in claim 13. No new matter is therefore added.

III. The rejection based on newly cited Nagashima et al., U.S. 5,742,735.

Claim 13 claims "direct driving motors." The USPTO reasons at page 3 of the Office Action that even if Nagashima does not disclose this limitation explicitly ("driving means" is all that the Nagashima discloses, i.e., no specific kind of driving means are disclosed); it is well known to drive motors linearly and/or directly. In accordance with MPEP 2144.03, applicants respectfully "seasonably challenges" such an unsupported assertion and requires that a reference be provided or "Official Notice" be taken. Otherwise, an affidavit of the Examiner is required by MPEP 2144.03.

It is respectfully noted that basically, as it stands now, the USPTO switched the case to another Examiner who cited a new reference in the final rejection for the first time and ignored applicants claim 16 allowable subject matter argument presented, and then made the rejection final on a second Office Action even though applicants merely made a few small 112 amendments. This is not proper or allowed in accordance with the MPEP 706.07(a) because applicants amendments did not necessitate a new reference being cited (a new ground of rejection). Instead, applicants merely clarified some language in accordance with 35 USC 112 and pointed out what the clarified language meant.

Therefore, applicants respectfully request that the finality of the Office Action be withdrawn, and that applicants arguments herein be given careful consideration. In any event, applicants respectfully note that theses arguments are also proper after final rejection according to 37 CFR 1.116 and do not require a new search, etc., because they merely place the claims in condition for allowance by respectfully addressing the Examiner's 112 concerns.

It is respectfully asserted that the rejection's lack of rigor makes a difference in this case. For example, stepper motors which the Examiner personally assumes are sufficient to teach the limitations of claim 13 are not according to the applicants, in fact accurate enough to be used in or operate with stereomicroscopes as claimed in claim 13. Also, in general a video camera patent disclosure (Nagashima and also see Uemura) with longer focal lengths and object distances (for example focal lengths of less than 10 cm are typical for stereomicroscopes) does not teach methods and structure accurate enough to be used with a stereo microscope as claimed in claim 13 for focusing. These "accuracy" based arguments were already made in the response filed September 5, 2002 by applicants in regard to the previously cited reference Thomas and Uemura. Therefore, these "technically incompatible" and impermissible "substantial redesign" arguments are not new arguments which require a new search (see amendment filed September 5, 2002 and citation of MPEP 2111.02, incorporated herein by reference). *For example, currently cited sole reference Nagashima (paragraph 5 of the Office Action) is an unrelated video camera application and cannot provide the required accuracy of motors and motor operation to be used in a stereo microscope arrangement as claimed in claim 13.*

Therefore, it is clear that a stereo microscope reference with disclosure of at least some kind of motor should have been cited, but instead the USPTO keeps citing unrelated and technically incompatible art. (applicants respectfully note that a simple key word search of the USPTO patent database could probably find much better references for example, and considering that the final rejection was premature and must be withdrawn according to MPEP 706.07(a), it seems clear that a non final Office Action or an allowance should be issued).

Therefore, the newly cited reference suffers from the same deficiencies as Thomas because it is technically incompatible and non-analogous art, and more importantly it does not explicitly teach all of the limitations of claim 13 as admitted by the USPTO on page 3 of the Office Action in regard to linear and/or direct drive motors. Therefore, at least another reference is required and preferably one from the stereo microscope art with a motor. Additionally, the Examiner's personal assumptions respectfully cannot be a basis for a rejection unless MPEP 2144.03 is complied with. Therefore, overall the current rejection of independent claim 13 at paragraph 5 is flawed and traversed herein.

Applicants have noted that the rejection at paragraph 5 seems to discount the

stereomicroscope limitations in the preamble of claim 13 and therefore paragraph 5 of the Office Action elects to not cite the admitted prior art in combination as done in paragraph 6.

Furthermore, the Examiner's "intended use" preamble argument is a common argument, but it is respectfully incorrect in this case. Preambles can properly limit the claim as described in MPEP 2111.02. For example claim 13 -- even before amendment -- is an apparatus claim claiming structure located "in a stereo microscope". For example, can the structure of the claim 13 (before amendment herein) be located somewhere other than in a stereo microscope structurally? Clearly, all of the limitations are structurally limited to being located structurally "in a stereomicroscope" *per se*. Therefore, the rejection at paragraph 5 is overcome because it did not cite the admitted prior art in combination as done at paragraph 6 for example. Therefore, claims 13 and 14 are allowable as the rejection is traversed.

However, applicant is cooperating and has put the same language into the body as well. Therefore, again this amendment cannot be said to require a new search, introduce new matter, or do anything impermissible after final rejection. The fact is that all along it has been clear that applicant has been claiming an apparatus in a stereo microscope, so at least one stereo microscope prior art reference should have been cited to support any rejection .

Additionally, Although the Examiner is respectfully believed to be well versed in the law of obviousness, and combination of references law, the relevant law is reproduced below for completeness of the record because the requisite 1. "motivation to combine," 2. "reasonable expectation of success" and 3. "teaching of all the limitations" reasoning was not provided in the previous Office Action as required under 35 USC 103.

In order to establish a *prima facie* case of obviousness under 35 USC 103 according to section 706.02(j) of the Manual of Patent Examining Procedure (MPEP) the following criteria must be met:

The MPEP Standard for Combining/Modifying References

The Manual of Patent Examining Procedure, section 706.02(j) sets forth the standard for combining and/or modifying prior art, and states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. **First,**

there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria. [Bold emphasis provided.]

For example, why would someone in the stereo microscope art look to the video camera art without any teaching to do so given the focal length issues? Where is the required teaching and motivation to combine and reasonable expectation of success discussed in the rejection to establish a *prima facie* case of obviousness as required by MPEP 706.02(j) citing 35 USC 103? Is it reasonable that someone who looks at a video camera patent will be able to make a highly accurate stereo microscope from it especially when the right kind of accuracy cannot be achieved by using a video camera application? This respectfully just does not make sense at a fundamental level. Therefore, for the reasons in MPEP 706.02(j) the USPTO's rejection is also flawed and traversed herein.

Unfortunately, applicant's previous response already pointed out the requirements of MPEP 706.02(j) and 2143.01 to the Examiner, but they were ignored again and another technically incapable reference was cited without the required MPE 706.02(j) reasoning and is now the only properly cited basis for the rejection. Thus, this current rejection is clearly a petitionable and/or successfully appealable as it stands currently because the Examiner cannot repeatedly ignore 35 USC 103 and MPEP 706.02(j), MPEP 2143.01, and MPEP 2144.03 when they are specifically invoked, cited and discussed by the applicants.

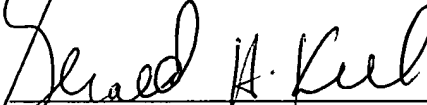
The remaining claims depend from claim 13 and are therefore also allowable.

IV. Conclusion.

In light of the *FESTO* case, no argument or amendment made herein was related to the

statutory requirements of patentability unless expressly stated herein. No claim amendment or argument made was for the purpose of narrowing the scope of any claim unless Applicant has explicitly stated that the argument is "narrowing." It is respectfully requested that all of the claims be reconsidered and allowed. An early and favorable action on the merits is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Gerald H. Kiel", is written over a horizontal line.

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GHK/DPL:



Fig. 1

Known technical solution for a motorized zoom (e.g., operation microscope)

Example: Greenough system

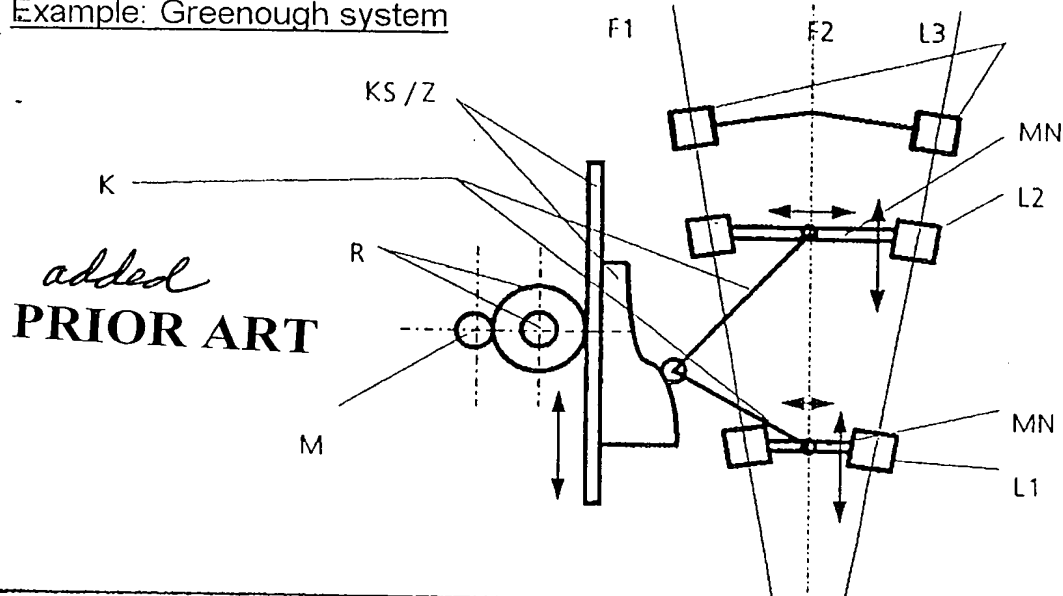


Fig. 2

